

Our Reference: MNI-100-TM

TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Applicant: M & N Plastics
Serial Number: 76/182,175
Filing Date: December 8, 2000
International Class Number: 020
Examining Attorney/Law Office: Brian J. Pino/114
Mark: JOE COOL


10-06-2003
U.S. Patent & TMO/TM Mail Rpt Dt. #22

APPLICANT'S REPLY TO EXAMINING ATTORNEY'S APPEAL BRIEF

Box TTAB
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Sir:

The Examining Attorney refused registration of Applicant's mark because he believes the specimen shows the mark being used in an ornamental manner. While the Examiner's judgement as to whether or not a word/design functions as a trademark may be entitled to a presumption of correctness, the Board in In re Tilcon Warren, Inc. 221 USPQ 86 (TTAB 1984) indicated this determination/judgement may be overcome by the Applicant. The Applicant believes it has done this, demonstrating its mark, as used on plastic sleeves for hot drink cups, is not merely ornamental. The facts in Tilcon Warren, supra, were much different than the facts presented in this case. In Tilcon Warren, supra, WATCH THAT CHILD (a slogan/phrase) was displayed on the bumper of a truck. The Board agreed with the Examiner that this mark did not function as a trademark for construction material, namely crushed stone and

other aggregates. Not only was it not used directly on the goods but it was a safety slogan on the trucks. This is not the situation in this case now before the Board. The mark *JOE COOL* is directly on the goods and while it may be a well-known term, it is certainly capable of distinguishing Applicant's goods from those of others.

A. COMMERCIAL IMPRESSION

The Examiner alleges that because *JOE COOL* is a common phrase, it is not inherently distinctive. The Applicant submits that *JOE COOL* on plastic sleeves for drink cups is inherently distinctive. This objection was never raised by the Examiner in his initial review and allowance of the mark. There is no other usage of this term on these types of goods. The fact that Charles Shultz popularized this wording to describe a persona of his *SNOOPY* dog character is irrelevant. If the Applicant was using a caricature/drawing depicting a figure on the sleeve or a Snoopy dog, perhaps the Examiner's argument would have some merit. As used by this Applicant, the words are not ornamental, but source identifying.

There are, in fact, other *JOE COOL* marks which have acquired Federal Registration. See U. S. Reg. No. 2,033,840; 1,463,754; 2,502,594; 22,493,298 and U. S. Application Serial No. 78/268,842.

The term *JOE COOL* does not appear in the dictionary as do some other "JOE" expressions, i.e., *JOE BLOW*, *JOE COLLEGE* and *JOE DOAKES*. See Random House Webster's Unabridged Dictionary, 2nd Edition, New York: Random House 2001. Even these definitions all describe a human character, not an inanimate object like a plastic thermal sleeve.

The Examiner's position is further unacceptable because, if correct, any popular expression (i.e., RIGHT ON/WRITE ON) would be precluded from ever being a trademark. The

inaccuracy of his reasoning is clearer because (a) this objection was not initially even raised in the examination/allowance and (b) because had the Applicant submitted its mark *JOE COOL*, on the sleeves in a smaller manner, it appears this would have then been acceptable to the Examiner. The cases cited by the Examiner for support are all distinguishable from this instant situation. The goods in all are either wearable items, (usually ornamented), or dishes, (again usually ornamented). The marks cited also are slogans or have an additional "message" conveyed with a graphic. *JOE COOL* does not. For example, in *Damn I'm Good Inc. v. Salowitz, Inc.*, 212 USPQ 684 (S.D.N.Y. 1981), the mark *DAMN I'M GOOD* was placed on bracelets, purses, and necklaces. The words "damn I'm good" was seen as a message the wearer of the item wished to convey not a statement as to the quality or source of the bracelet (a mark). As the Applicant has pointed out, the mark is "seen" only by the purchasers who will use the goods to place over their cups in their retail establishments. The mark is not used to allow the buyer of McDonald's coffee feel "cool" or offer "JOE COOL" status to the purchaser of a hot chocolate from Starbucks. These individuals would most likely not even notice the mark but would instead see the retailer's designs/marks and not suffer burned hands.

The case of In re Pro-Line Corp., 28 USPQ 2,114, (TTAB 1993) also involved wearable items, with the mark *BLACKER THE COLLEGE SWEETER THE KNOWLEDGE* placed in very large letters across a sweatshirt with the names of educational institutions appearing in smaller letters underneath this phrase. Clearly this conveys a message promoting the value of education at these particular colleges. As the Board stated, it is part of a thematic whole design or message - - not a source indicator of the shirt. This thematic theme was also found in In re Dimitri's, Inc., 9 USPQ 2d 1666 (TTAB 1988) wherein the mark *SUMO* was used

on shirts with Sumo wrestlers depicted and in In re Astro Gods, Inc., 223 USPQ 621 (TTAB 1984) wherein the mark *ASTRO GODS* appears on shirts with a design legend depicting the gods.

The mark in In re Original Red Plate Company, 223 USPQ 836 (TTAB 1984) can also be distinguished from the instant case. The mark *YOU ARE SPECIAL TODAY* in white letters on a plain red plate stands out as an ornamentation and a message. In addition, the mark *YOU ARE SPECIAL TODAY* was not used in any advertisement as is the case with *JOE COOL* but the goods were referred to as "Special Day Plate."

With respect to the size/placement, the Examiner states the Applicant's mark is made more obvious by its size and location and, therefore, doesn't function as a mark. The Applicant applied to register its mark *JOE COOL* in typed version thereby permitting presentation/stylization in any manner. Trademarks are often large and dominant on goods and may appear in more than one location, as, for example, a can of COKE® (See Exhibit A).

When a mark is submitted in typed form, the mark may then be stylized in any manner when used on the goods in commerce. See Squirt v Tomy Corporation, 216 USPQ 937 (CAFC 1983); MSI Data Corporation v Microprocessor Systems, Inc., 220 USPQ 655 (TTAB 1983). The Examiner has taken the incorrect position that because the Applicant has elected to use its mark in stylized form on two sides of its plastic sleeves, it is ornamental and not now functioning as a trademark. When issuing this refusal, the Examiner stated the Applicant could overcome this refusal by submitting advertising materials promoting the subject matter (*JOE COOL*) as a mark. (June 18, 2002 Office Action.) Accordingly, the Applicant submitted promotional materials (Exhibit B) displaying the mark/clear plastic sleeves) with the language "There is something to be said for going unnoticed" and "JOE COOL™" and "It goes unnoticed

so you don't" with a cup design showing with only ridges of the plastic sleeve apparent, and the statement, "The carefully developed graphics on your cup reflect the image you've created. It's what you say about yourself to your customer..." The content of this material is not to have a person look "cool" using the plastic sleeve but promoting the goods as environmentally safe, (neat feature or "cool") and reusable (neat feature or "cool") and providing exceptional insulation (neat feature or "cool") and environmentally safe (neat feature or "cool") and a capability of showing purchaser's (retailer, i.e., McDonald's, Starbucks not the drinker of coffee) graphics through clear sleeve, and even capable of embossing the purchaser/retailer's graphics on the actual goods (neat feature or "cool".) The mark *JOE COOL* is what is promoted in these materials, not, as the Examiner suggests on his last page, some design or accessory for a person to look cool when using. The ads are directed toward the retail purchaser to use on its cups and not even have the purchaser's customers notice the Applicant's goods. The picture displays a cup, with the goods in use on the cup, and the message "It goes unnoticed so you don't" over the mark so that the mark is not really even seen and only the ridges can be clearly made out to the reader. The Applicant's mark, *JOE COOL*, is placed on the goods purely to be a means of clearly indicating source, not to ornament the goods. If the Applicant was intending to use its mark in an ornamental or decorative fashion, Applicant would have used colors so the mark would always be visible. The Applicant wanted to display its mark on the goods clearly so its purchasers would see the mark, but it is purposely not ornamental/decorative as these purchasers want their marks/designs (McDonald's/Starbucks) to be visible to their customers.

It is also significant that the mark, as applied to thermal protection sleeves, has a double meaning; i.e, it keeps the user's hands "cool." This is a common factor in many trademarks and militates against ornamentality.

B. PRACTICES OF THE TRADE

The Examiner states that Applicant has not provided any evidence that placing *JOE COOL* in large, stylized letters on its goods is common practice in the trade. The Applicant has set forth in its response to the Office Action and in its Appeal Brief that the purpose of placing the mark on its particular goods in the fashion in which it is so placed, was for the purpose of source identification. Hot/cold drink covers often bear a trademark in prominent fashion. A trademark owner of a mark registered in typed format can display this mark in any stylization. Trademarks often appear large on the goods and on boxes containing the goods. As for practices on thermal cups, the Applicant believes it is a commonly recognized practice for trademarks to appear on insulators and sleeves. A trip to any retail establishment selling "drinks to go" provides these (for examples, see Exhibit C). Bearing this in mind, the Applicant's specimens become even more acceptable of its trademark usage because the Applicant is trying to assist these retail establishments by making the goods/mark "invisible" so the retailer's designs and/or marks are clearly visible.

C. SECONDARY SOURCE and

D. DISTINCTIVENESS.

The Applicant has used its mark since November, 2001 and on this product only and, therefore, cannot yet show evidence of secondary source/distinctiveness. The Applicant respectfully submits, however, that because its mark, used on its goods, is inherently distinctive and is not used in an ornamental fashion, such a showing is unnecessary.

CONCLUSION

The Applicant believes it has shown that its mark, *JOE COOL*, on its plastic sleeves for hot drink cups will be perceived as an indicator of source to its purchasers and not as

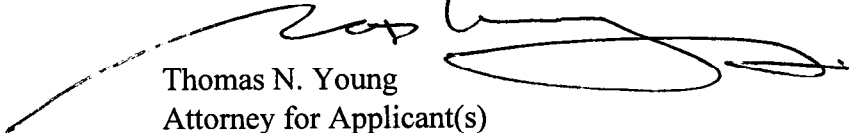
ornamentation. The term *JOE COOL* as applied to plastic sleeves for hot cups is inherently distinctive. The application displays the mark in typed form so any size/stylization is acceptable. The mark is not colored, does not have an added design (such as a sumo wrestler, god legend or names of schools) nor is it a message that would be conveyed when a party was using the goods (such as Damn I'm Good). When actually in use, the mark would barely be visible.

The Examiner somehow thinks the goods of the Applicant are designed to enable a person to assume the persona of a cultural phenomenon, i.e., "feel cool." In reality, from the Applicant's/Purchaser's (Retailer) perspective, the thermal sleeve provides the desired coolness by insulating the hot drink cup from the actual user's hands. The advertising of the Applicant reflects this intention.

Reversal of the Examiner's refusal to register based upon the facts and Applicant's briefs is hereby respectfully requested.

Respectfully submitted,

YOUNG & BASILE, P.C.



Thomas N. Young
Attorney for Applicant(s)
Registration No. 20,985
(248) 649-3333

3001 West Big Beaver Rd., Suite 624
Troy, Michigan 48084-3107
Dated: September 29, 2003
TNY/KGM/dge



UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Electronic Search System

EXHIBIT B
Serial No. 76/182,175

TESS was last updated on Sat Sep 27 04:22:17 EDT 2003

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 List At: OR to record: **Record 6 out of 11**
Check Status

(TARR contains current status, correspondence address and attorney of record for this mark. Use the "Back" button of the Internet Browser to return to TESS)

Typed Drawing

Word Mark	JOE COOL
Goods and Services	IC 025. US 022 039. G & S: FOOTWEAR. FIRST USE: 20010200. FIRST USE IN COMMERCE: 20010401
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	75756845
Filing Date	July 21, 1999
Filed ITU	FILED AS ITU
Published for Opposition	January 11, 2000
Registration Number	2493298
Registration Date	September 25, 2001
Owner	(REGISTRANT) United Feature Syndicate, Inc. CORPORATION NEW YORK 200 Madison Avenue, 4th Floor New York NEW YORK 10016
Attorney of Record	Melanie S. Corcoran
Prior Registrations	1463754
Type of Mark	TRADEMARK
Register	PRINCIPAL
Live/Dead Indicator	LIVE

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List At: OR to record: **Record 7 out of 11**

Check Status

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Typed Drawing

Word Mark COOL:JOE
Goods and Services IC 009. US 021 023 026 036 038. G & S: component-oriented and object-oriented computer software development and design tools for use in analyzing, creating, documenting and maintaining scalable enterprise business models, and that provide component modeling, physical implementation, design, test and debug support, and printed instructional manuals, therefor, sold as a unit. FIRST USE: 19990120. FIRST USE IN COMMERCE: 19990120

Mark Drawing Code (1) TYPED DRAWING

Serial Number 75689691
Filing Date April 23, 1999
Filed ITU FILED AS ITU
Published for Opposition January 25, 2000
Registration Number 2502594
Registration Date October 30, 2001
Owner (REGISTRANT) STERLING SOFTWARE, INC. CORPORATION
 DELAWARE 300 Crescent Court, Suite 1200 Dallas TEXAS 75201
Attorney of Record JERRY W. MILLS, ESQ.
Prior Registrations 2243581;2243582;2243583;2243584;2251862;AND OTHERS
Type of Mark TRADEMARK
Register PRINCIPAL
Live/Dead Indicator LIVE

• **Live/Dead Indicator** LIVE

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Typed Drawing

Word Mark	HAIRCUTS BY JOE COOL
Goods and Services	IC 042. US 100 101. G & S: hair cutting salon. FIRST USE: 19930424. FIRST USE IN COMMERCE: 19930424
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	75063749
Filing Date	February 26, 1996
Published for Opposition	November 5, 1996
Registration Number	2033840
Registration Date	January 28, 1997
Owner	(REGISTRANT) Sannicandro, Joseph S. INDIVIDUAL UNITED STATES 5025 Golden Gate Parkway Naples FLORIDA 33116
Disclaimer	NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "HAIRCUTS" APART FROM THE MARK AS SHOWN
Type of Mark	SERVICE MARK
Register	PRINCIPAL
Affidavit Text	SECT 8 (6-YR).
Live/Dead Indicator	LIVE

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Typed Drawing

Word Mark	JOE COOL
Goods and Services	IC 028. US 022. G & S: SKATEBOARDS. FIRST USE: 19860822. FIRST USE IN COMMERCE: 19860822
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	73656405
Filing Date	April 16, 1987
Published for Opposition	August 11, 1987
Registration Number	1463754
Registration Date	November 3, 1987
Owner	(REGISTRANT) UNITED FEATURE SYNDICATE, INC. CORPORATION NEW YORK 200 PARK AVENUE NEW YORK NEW YORK 10166
Attorney of Record	FRANK H. ANDORKA
Type of Mark	TRADEMARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR).
Live/Dead Indicator	LIVE

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TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:) CERTIFICATE OF MAILING
)
BLOCK HEADWEAR LTD.) I hereby certify that this correspondence is
) being deposited with the United States Postal
) Service as first class mail with sufficient
Serial No.: 76/352,692) postage in an envelope addressed to: Assistant
) Commissioner For Trademarks, 2900 Crystal
Filed: December 21, 2001) Drive, Arlington, VA 22202-3513, the
) 3rd day of March, 2003.
Examiner: Jason F. Turner)
)
Law Office 108) Dawn M. Oleszak 3-8-03
) Dawn M. Oleszak Date
Mark: BLOCK and Design)

REQUEST TO AMEND IDENTIFICATION OF GOODS

ASSISTANT COMMISSIONER
FOR TRADEMARKS
2900 Crystal Drive
Arlington, VA 22202-3513

Sir:

Applicant requests that the goods in the above-identified application be amended to read as follows:

-- HEADWEAR NOT IN THE FIELD OF DANCEWEAR OR
ATHLETICS --.

The amended goods accurately reflect applicant's goods, are believed to be in acceptable form, and are within the scope of the original identification.

Respectfully submitted,

COS 11
Cobby J. Shereff

Boyle, Fredrickson, Newholm,
Stein & Gratz, S.C.
250 East Wisconsin Avenue, Suite 1030
Milwaukee, Wisconsin 53202
(414) 225-9755
Attorney Docket No.: 507.001

TTAB

Our Reference: MNI-100-TM

TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Applicant: M & N Plastics
Serial Number: 76/182,175
Filing Date: December 8, 2000
International Class Number: 020
Examining Attorney/Law Office: Brian J. Pino/114
Mark: JOE COOL

10-06-2003
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CERTIFICATE OF MAILING AND TRANSMITTAL LETTER

Attn: Box TTAB
Commissioner for Trademarks
2900 Crystal Drive
Arlington, Va. 22202-3513

Sir:

Transmitted herewith is a postcard; an Appeal Brief (in triplicate); and Exhibits A - C in triplicate in the above-identified trademark application.

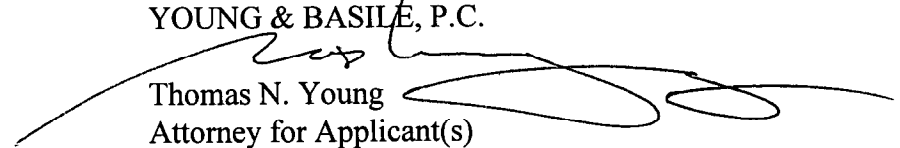
X No additional fee is required.

X Please charge any additional fees or credit overpayment to Deposit Account Number 25-0115.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Attn: TTAB, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Va. 22202-3513, on **September 29, 2003**.

Respectfully submitted,

YOUNG & BASILE, P.C.


Thomas N. Young
Attorney for Applicant(s)
Registration No. 20,985
(248) 649-3333

3001 West Big Beaver Rd., Suite 624
Troy, Michigan 48084-3107
Dated: September 29, 2003
TNY/KGM/dge